

Amendment and Response

Applicant: Michael J. Brosnan

Serial No.: 09/811,001

Filed: March 13, 2001

Docket No.: 10010038-1

Title: PORTABLE ELECTRONIC DEVICE WITH MOUSE-LIKE CAPABILITIES

REMARKS

This Amendment is responsive to the Office Action mailed April 28, 2004. In that Office Action, the Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter.

The Examiner rejected claims 1, 2, 4-7, 10, 11, 13-15, 18, 19, and 22 under 35 U.S.C. §102(b) as being anticipated by Paloniemi et al., U.S. Patent Publication No. 2001/0017934 ("Paloniemi"). Claims 3, 8, 9, 12, 16, 17, 20, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paloniemi in view of Gordon et al., U.S. Patent No. 6,057,540 ("Gordon").

With this Response, claims 1, 5, 7-9, and 14-21 have been amended. Claims 1-22 remain pending in the application and are presented for reconsideration and allowance.

Objections to Specification

The Examiner objected to the specification under 37 C.F.R. 1.75(d)(1) and MPEP § 608.01(o), as failing to provide proper antecedent basis for the claimed subject matter. The Examiner indicated that the term "two-dimensional relative movement" appearing in claim 1 has no clear support in the specification. (Office Action at para. no. 1, page 2). Applicant submits that the term "two-dimensional relative movement" is supported by the specification. For example, the specification indicates that the motion detection device 20 tracks "the **relative movement** of a work surface or an imaging surface" (Specification at page 9, lines 26-28) (emphasis added). The specification also indicates that "leftward", "rightward", "upward", and "downward" movements are sensed, and that " ΔX and ΔY " or "(X, Y)" information is generated. (See, e.g., specification at page 7, line 1, to page 12, line 29). The terms "leftward", "rightward", "upward", "downward", " ΔX and ΔY ", and "(X, Y)" provide clear support to indicate that the movement is "two-dimensional". Nonetheless, with this Amendment, Applicant has amended the specification pursuant to MPEP § 608.01(o), and added the words "two-dimensional". As stated in section 608.01(o) of the MPEP, "[w]hile an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims." Since the term "two-dimensional"

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is clearly supported by the specification as originally filed, Applicant submits that this amendment to the specification does not add new matter. Approval of this amendment to the specification, and removal of the objection to the specification under 37 C.F.R. 1.75(d)(1) and MPEP § 608.01(o)) is respectfully requested.

The Examiner also stated that “[t]he use of a confusing variety of terms for the same things is not allowed: ‘a motion sensor’ (claims 1-10 and 14-17), ‘a motion detector’ (claims 18-22), and ‘a motion detector device’ (specification, page 7, lines 15-16).” (Office Action at para. no. 1, page 2). Applicant respectfully disagrees that the term “motion detector device” is used on page 7 of the specification. Rather, the term “motion detection device” is used on page 7 of the specification. With this Amendment, Applicant has amended claims 1, 5, 7-9, and 14-21, to change “motion sensor” and “motion detector” to “motion detection device”. Removal of the objection to the specification under 37 C.F.R. 1.75(d)(1) and MPEP § 608.01(o)) is respectfully requested.

35 U.S.C. §102 Rejections

The Examiner rejected claims 1, 2, 4-7, 10, 11, 13-15, 18, 19, and 22 under 35 U.S.C. §102(b) as being anticipated by Paloniemi et al., U.S. Patent Publication No. 2001/0017934 (“Paloniemi”). Independent claim 1, as amended, includes the limitations “generating a second set of movement data with the [motion sensor] motion detection device indicating an amount and direction of a second relative movement between the portable electronic device and the imaging surface”, and “selecting the first menu item based on the second set of movement data.” Independent claim 5, as amended, includes the limitations “the [motion sensor] motion detection device . . . configured to generate a second set of movement data indicating an amount and direction of a second relative movement between the portable electronic device and the imaging surface” and “the controller configured to select the first menu item based on the second set of movement data.”

Paloniemi does not teach or suggest selecting a menu item based on movement data as recited in claims 1 and 5. Rather, Paloniemi discloses that selections are made with “a selection button or key”, or by a “finger tap, to the fingerprint sensor”. (Paloniemi at page 3, para. no. 31). There is no teaching or suggestion in Paloniemi that movement data is generated in response to pressing a selection button or key, or tapping the fingerprint sensor.

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In view of the above, independent claims 1 and 5 are not taught or suggested by Paloniemi. In addition, dependent claims 2, 4, 6, 7, and 10, which further limit patentably distinct claim 1 or claim 5, are also believed to be allowable over the cited reference. Allowance of claims 1, 2, 4-7, and 10 is respectfully requested.

Independent claims 11, 14, and 18, each include the limitations “storing movement pattern data representing a first pattern of relative movement between the portable electronic device and an imaging surface”, “generating a first set of motion data” the first set of motion data “representing a second pattern of relative movement between the portable electronic device and an imaging surface”, and “comparing the first set of motion data to the stored movement pattern data”. Paloniemi does not teach or suggest identifying a user, or enabling operation of a portable electronic device, based on a comparison of stored movement pattern data representing a first pattern of relative movement with a set of motion data representing a second pattern of relative movement. Rather, Paloniemi discloses that, in a “fingerprint input mode”, an image of a user’s fingerprint is formed, and this image is then compared to a stored fingerprint image. (See, e.g., Paloniemi at page 3, para. no. 32). If the images match, the device switches to a “motion input mode”. (See, e.g., Paloniemi at page 3, para. no. 32). The disclosure in Paloniemi that two fingerprint images are compared to determine if they match does not teach or suggest comparing stored movement pattern data representing a first pattern of relative movement with a set of motion data representing a second pattern of relative movement. It does not appear that motion data is even generated during the fingerprint input mode of Paloniemi.

In view of the above, independent claims 11, 14, and 18, are not taught or suggested by Paloniemi. In addition, dependent claims 13, 15, 19, and 22, which further limit patentably distinct claim 11, 14, or 18, are also believed to be allowable over the cited reference. Allowance of claims 11, 13-15, 18, 19, and 22 is respectfully requested.

35 U.S.C. §103 Rejections

The Examiner rejected claims 3, 8, 9, 12, 16, 17, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Paloniemi in view of Gordon et al., U.S. Patent No. 6,057,540 (“Gordon”). Claims 3, 8, 9, 12, 16, 17, 20, and 21 are each dependent on one of independent claims 1, 5, 11, 14, and 18. As described above with reference to these independent claims,

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Paloniemi does not teach or suggest the above-quoted limitations of these claims. Gordon also does not teach or suggest the above-quoted limitations of these claims. There is also no suggestion to combine Paloniemi and Gordon.

In view of the above, dependent claims 3, 8, 9, 12, 16, 17, 20, and 21, which further limit patentably distinct claim 1, 5, 11, 14, or 18, are also believed to be allowable over the cited references. Allowance of claims 3, 8, 9, 12, 16, 17, 20, and 21 is respectfully requested.

Allowable Subject Matter

In light of the above, Applicant believes independent claims 1, 5, 11, 14, and 18, and the claims depending therefrom, are in condition for allowance. Allowance of these claims is respectfully requested.

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CONCLUSION

Any inquiry regarding this Amendment and Response should be directed to Jeff A. Holmen at the below-listed telephone number or Pamela Lau Kee at Telephone No. (408) 553-3059, Facsimile No. (408) 553-3063. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 27th day of July, 2004.

By Jeff A. Holmen
Name: Jeff A. Holmen